

229



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,872	02/29/2000	Isabelle Morvan	1807.1094	1542

5514 7590 09/03/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 09/03/2003

//

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,872

Applicant(s)

MORVAN ET AL.

Examiner

Patrice L Winder

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) 49-108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 49-108 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-48, drawn to a method of communicating between communication stations wherein the method includes a request for the storage in memory and transmission by said mobile station of a message to a communication station for which the message is intended and which is not synchronized with a first base station, classified in class 455, subclass 412.
 - II. Claims 49-81, drawn to a method of communicating between communication stations, wherein the source station performs: an operation of synchronization with a base station or destination station and an operation of communicating with the destination station, classified in class 455, subclass 445.
 - III. Claims 82-108, drawn to a method of communication between communication stations wherein a first station of a first cell performs: an operation of determining the need for information on a second station, concerning a cell in which at least one third station is situated, and when such information is necessary, an operation of transmitting, to the second station, a message representing the cell in which at least one third station is situated, classified in class 455, subclass 436.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of using store and forward mechanisms to facilitate message transmission. See MPEP § 806.05(d).
3. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a method of determining the next destination for a message in a mobile communication system. See MPEP § 806.05(d).
4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a method of providing location/positioning information for communication between mobile stations. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 2155

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicant's election with traverse of claims 1-48 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that there is undue burden for the search. This is not found persuasive because the inventions separately classified as explained above and thus facilitate separate searches.

The requirement is still deemed proper and is therefore made FINAL.

9. Claims 49-108 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group of inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.

Art Unit: 2155

- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 2155

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheatley, III et al., USPN 6,307,840 (hereafter referred to as Wheatley) in view of Blakeney et al., USPN 5,267,261 (hereafter referred to as Blakeney).

Regarding claim 1, Wheatley taught a method of communicating between communication stations adapted to communicate with each other when at least one of said communication stations supplies a synchronization signal, said station then

functioning in base station mode and the stations not supplying a synchronization signal but synchronizing on a synchronization signal sent by a station functioning in base station mode then functioning in mobile station mode (column 3, line 66 – column 4, line 10),

wherein the method includes a request operation during which a first base station transmits, to a mobile station, a request for the storage in memory and transmission (column 5, lines 40-42), by said mobile station, of a message to a communication station for which the message is intended and which is not synchronized with said first base station (column 5, lines 22-26). Wheatley does not specifically teach all the steps for a soft handoff. However Blakeney taught the steps for a soft handoff (column 2, lines 24-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Blakeney's soft handoff in Wheatley's system for

mobile assisted synchronization because doing so would have improved Wheatley's handoff technique.

Regarding dependent claim 2, Blakeney taught further including a response operation during which said mobile station transmits, to said first base station, a message accepting or refusing transmission of said message to the message destination station (column 27, lines 30-34).

Regarding dependent claim 3, Blakeney taught when said mobile station transmits an acceptance message to the first base station, it next performs a detachment operation, during which said mobile station desynchronizes from the first base station (column 27, lines 30-39).

Regarding dependent claim 4, Blakeney taught following said detachment operation, said mobile station performs an attachment operation during which it synchronizes with a second base station (column 27, lines 40-47). Wheatley taught without the two base stations synchronizing with each other ().

Regarding dependent claim 5, Blakeney taught following said attachment operation, the mobile station performs a second transmission operation, during which said mobile station transmits said message to the message destination station (column 27, lines 1-58).

Regarding dependent claim 6, Wheatley taught as a preliminary to said request operation, the first base station performs an operation of selecting, from a location table, the mobile station which is the destination of the request to store in memory and to transmit (column 7, lines 10-24).

Regarding dependent claim 7, Wheatley taught if during the response operation the mobile station transmits to the first base station a message refusing transmission of said message, the base station performs a new operation of selecting, from a location table, a mobile station which is the destination of the request to store in memory and to transmit (column 7, lines 10-24).

Regarding dependent claim 8, Wheatley taught as a preliminary to the selection operation, the first base station performs an operation of determining synchronization or not of the message destination station with the first base station and, only when the message destination station is not synchronized with the first base station, an operation of selecting a mobile station which is the destination of the request to store in memory (column 4, lines 11-24).

Regarding dependent claim 9, Blakeney taught during the operation of determining the synchronization or not of the message destination station with the first base station, the base station performs an operation of reading, in a location table, the operating mode of the message destination station, (column 25, lines 6-18).

Wheatley taught when the message destination station is functioning in base station mode, it is determined that the message destination station is not synchronized with the first base station (column 4, lines 11-24), and

when the message destination station is functioning in mobile station mode, during said reading operation, the base station performs an operation of reading the identity of a base station with which the message destination station is synchronized and, when the base station with which the message destination station is synchronized

is not the first base station, it is determined that the message destination station is not synchronized with the first base station (column 4, lines 11-24).

Regarding dependent claim 10, Blakeney taught during the request operation, the first base station transmits, to the mobile station, the content of the message to be transmitted to the message destination station (column 25, lines 6-18).

Regarding dependent claim 11, Blakeney taught during the request operation, the first base station transmits, to the mobile station, an identifier for the message destination station (column 27, lines 30-66).

Regarding dependent claim 12, Blakeney taught during the request operation, the first base station transmits, to the mobile station, an identifier for the first base station (column 27, lines 30-66).

Regarding dependent claim 13, Blakeney taught during the request operation, the first base station transmits, to the mobile station, an identifier for a source station which supplies, to the first base station, the message to be transmitted to the message destination station (column 26, lines 47-66).

Regarding claims 36, Wheatley taught network, characterized in that it has at least two devices (column 5, lines 13-26).

Regarding dependent claim 37-45, Wheatley taught Telephone, Photographic apparatus, Printer. Scanner, Camera, Computer, Facsimile machine, Television receiver, or Audio/video player, characterized in that it has a device according to any one of Claims 24 and 33 (mobile station 60, column 5, lines 13-26).

The language of claims 14-35, 46-48 is substantially the same as claims 1-13. Therefore, claims 14-35, 46-48 is substantially the same as previously rejected claims 1-13.

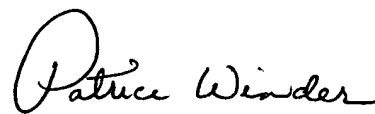
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ngo et al., USPN 6,377,549 B1 : taught hybrid mobile nodes that operate in a base station mode.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached on (703) 308-6662. The fax phone number(s) for this Group are after final (703) 746-7238; official (703) 746-7239 and non-official/draft (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


PATRICE WINDER
PRIMARY EXAMINER